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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,570	07/16/2001	Guenter Jokschas	178/50178	2329

23911 7590 05/21/2003

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EXAMINER

SAVAGE, MATTHEW O

ART UNIT PAPER NUMBER

1723

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,570

Applicant(s)

JOKSCHAS, GUENTER

Examiner

Matthew O Savage

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7. 6) ☐ Other:

With respect to the amendment filed on 2-21-03, lines 12-15 of amended claim 1 included new limitations should have been underlined.

With respect to the statement in the previous office action that applicant's claim for foreign priority under 35 U.S.C. 119 to German Patent Application 100 34 488.7 could not be granted since the instant U.S. Application had been filed more than one year after the filing of the German application, the statement is hereby withdrawn since the due date for benefit of priority foreign fell on Sunday, July 15, 2001 and because the application had been filed on the following business day, Monday, July 16, 2001.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to adequately disclose the recited means for arresting the actuator without the drive unit (see lines 19-26 of col. 6). It is

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suggested that claim 7 be amended to depend from claim 6 which recites the drive unit to obviate the rejection.

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification fails to disclose a lower spacer that is braced against the housing enclosure as recited on lines 14-15 of claim 1. Applicant should note that the intermediate metal plate is braced against the housing enclosure whereas the spacer is clamped between the filter element and intermediate plate.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Bolser.

With respect to claim 1, Bolser discloses a filter suitable for filtering diesel fuel comprising:

a filter housing comprising a filter head 28 and a housing enclosure C, a fuel inlet 30 and a fuel outlet 26 arranged on the filter housing, and a chamber capable of functioning as a water accumulation chamber (e.g., adjacent the bottom end of part C) which communicates with an outlet capable of functioning as a water outlet (e.g., the opening in the bottom of container C) provided in the housing enclosure since both the chamber and outlet are position at the lowermost part of the housing,

a cylindrical filter insert F installed in the filter housing such that an unfiltered side of the filter which communicates with the fuel inlet is sealingly separated from a filtered side of the filter which communicates with the fuel outlet, wherein the water accumulation chamber is disposed on the unfiltered side of the filter,

a lower spacer 41 including gaps through which water can reach the water accumulation chamber,

an intermediate metal plate 37, via which the lower spacer is braced against the housing enclosure,

a water discharge valve 80 at said water outlet, with an actuator 36 for opening the water discharge valve from outside the filter, and

wherein said actuator is connected to the filter head on the one hand and the water outlet on the other hand.

As to claim 3, Bolser discloses the actuator 36 as extending through the filter interior formed by the cylindrical element.

Concerning claim 4, Bolser discloses axial displacement of the actuator 36 as opening the outlet.

Regarding claim 5, Bolser discloses a water outlet that can be opened by pulling on the actuator (e.g., by pulling the actuator by pulling the exposed end of the valve member 80 after loosening or removing the nut 82).

As to claim 6, Bolser discloses a drive unit (e.g., the threaded connection between the parts 78 and 82).

As to claim 7, Bolser discloses means 82 for arresting the actuator to prevent unintended opening of the discharge valve.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolser in view of Van Scholack et al.

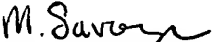
With respect to claim 2, Bolser fails to specify the recited sensor. Van Scholack et al disclose a sensor 14 arranged in a filter housing and teaches that such an arrangement provides an indication of whether or not water is present in the lubricating oil. It would have been obvious to have modified the filter of Bolser so as to have included a sensor as suggested by Ban Scholack et al in order to provide an indication as to whether or not water was present in the lubricating oil.

Claim 8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action.

Claim 1 would be allowable if amended to specify the intermediate metal plate as being an intermediate metal spring plate cooperating with the housing to brace the lower spacer against the filter insert.

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is 703-308-3854. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.


Matthew O Savage
Primary Examiner
Art Unit 1723

mos
May 19, 2003